

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE NIXON and PAUL BRENNAN

Appeal 2007-1355
Application 09/735,499
Technology Center 2100

Decided: July 17, 2007

Before ANITA PELLMAN GROSS, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 1-20. We have jurisdiction under
35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE INVENTION

The disclosed invention relates generally to messaging systems that provide notification of various types of messages that are available to a user. More particularly, the disclosed invention incorporates an application module that alerts and allows a user to quickly view notifications of new messages for which a notification has not been cleared (Specification 1, 6).

Independent claims 1 and 14 are illustrative:

1. A messaging system having integrated therewith a message notification means, said message notification means comprising:

memory means for storing message status information for messages in said messaging system;

means for determining from the stored message status information which messages in said messaging system are new and for which a notification has not been cleared;

a user interface for providing to a user a list of message notifications associated with only those messages determined to be new and for which a notification has not been cleared;

said message notification means permitting the user to select a particular notification from said list for manipulation.

14. A method of enhancing a messaging system, said method comprising the steps of:

providing a message notification application integrated with a messaging application of said messaging system;

storing message status information for messages in said messaging system;

determining from the stored message status information which messages in said messaging system are new and for which a notification has not been cleared;

presenting, to a user by said message notification means, a list of message notifications associated with only those messages determined to be new and for which a notification has not been cleared via a user interface; and

permitting said user to select a particular message notification from said list for manipulation.

THE REFERENCES

Helfman	US 6,396,513B1	May 28, 2002 (filed May 14, 1996)
Sylvan	US 5,943,055	Aug. 24, 1999

THE REJECTIONS

Claims 1, 2, 4, 5, 7, 8, and 12-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Helfman.

Claims 3, 6, and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Helfman in view of Sylvan.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

Claims 1, 7, 8, and 12-20

We consider first the Examiner's rejection of claims 1, 7, 8, and 12-20 as being anticipated by Helfman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 14 as the representative claim

for this rejection because we find it is the broadest independent claim before us. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that Helfman does not disclose a system “with the capability of determining which messages are both new *and* have not had a notification cleared,” as claimed (Br. 9, emphasis in original).

The Examiner disagrees. The Examiner argues that identifying the status of an e-mail message (e.g., whether the message is new) involves a determination that the e-mail message is unread which also indicates the e-mail message has a notification that has not been cleared (Answer 10). Specifically, the Examiner argues that Fig. 3A of Helfman provides a list of message notifications including indications of messages that are new (i.e., unread) and for which notification has not been cleared. The Examiner points to the “unread/tot” column in window 40 of Fig. 3A that indicates the number of unread messages (Answer 11-12).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)).

After carefully considering the evidence before us, we agree with the Examiner that Helfman discloses a user interface providing a list of message notifications, as clearly shown in Fig. 3A. Specifically, we find Helfman discloses a list of message notifications associated only with those messages determined to be *new* (*see* Fig. 3A, window 40, i.e., the “unread/tot” column

indicating the number of *unread* messages) *and* for which a notification has *not been cleared* (see Fig. 3A, window 40, i.e., the “unread/tot” column indicating the number of unread messages, where the number is a non-zero integer if the message has not been read). We find Helfman discloses that if all the messages in a mailbox have been read, then the count of unread (new) messages is cleared with a zero as indicated in the “unread/tot” column (*id.*). We further find that if at least one message in a mailbox has not been read, the notification (i.e., unread count) is not cleared (i.e., is a non-zero number). See Fig. 3A, col. 5, ll. 26-38.

In the Reply Brief, Appellants further argue “the claim recites listing messages that are new and for which a notification has not been cleared. *Not listed are messages that are new, but for which a notification has been cleared.*” (Reply Brief 2, last paragraph, emphasis added).

We note the argued negative limitation “[n]ot listed are messages that are new, but for which a notification has been cleared” is not claimed (*id.*). Appellants are arguing limitations found only within the Specification. We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). A basic canon of claim construction is that one may not read a limitation into a claim from the written description. *Renishaw plc v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). Here, we decline to read the limitations from the Specification (as argued by Appellants) into the claim. Because we find Helfman discloses all that is claimed, we find the Examiner has met the burden of presenting a *prima facie* case of

anticipation. Accordingly, we will sustain the Examiner's rejection of representative claim 14 as being anticipated by Helfman.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the selected claim alone. Therefore, we will sustain the Examiner's rejection of claims 1, 7, 8, 12, 13, and 15-20 as being anticipated by Helfman for the same reasons discussed *supra* with respect to representative claim 14.

Claim 2

We consider next the Examiner's rejection of dependent claim 2 as being anticipated by Helfman. We note that claim 2 recites: "A messaging system according to claim 1 wherein said manipulation consists of selecting a functionality associated with a plurality of options presented to the user."

Appellants argue that Helfman teaches a user interface displaying a list of mailboxes rather than a list of notifications. Appellants further argue that the portion of the reference cited by the Examiner merely discloses a description of steps in establishing a mailbox, rather than options presented to a user for manipulating a message notification (Br. 12).

After reviewing Helfman's invention as shown in Fig. 3A, we find that Helfman's mailboxes within "window 40" are part of the textual line corresponding to each message notification. Thus, we find Helfman discloses a list of notifications in window 40 of Fig. 3A. Because a user can select and open a mailbox and read an unread e-mail message (and thus manipulate the message notification by clearing it to zero unread messages), we find the weight of the evidence supports the Examiner's position.

Therefore, we will sustain the Examiner's rejection of claim 2 as being anticipated by Helfman.

Claim 4

We consider next the Examiner's rejection of dependent claim 4 as being anticipated by Helfman. We note that claim 4 recites: "A messaging system according to claim 1 wherein said messaging system is a unified messaging system."

Appellants argue Helfman does not disclose a unified messaging system, as claimed. Appellants interpret a unified messaging system as a system that manages different types of messages sent to a particular user, such as voice, facsimile, electronic mail, video or data messages. Appellants point to the support found in the Specification at page 1, lines 14-21 (Br. 12-13).

The Examiner disagrees. The Examiner argues that Helfman's messaging system is broadly a "unified messaging system" because Helfman's messaging system "unifies" messages of different types, e.g., for display on the screen to the user (Answer 12-13).

We see the question before us as whether Helfman discloses a "unified messaging system" consistent with Appellants' Specification (i.e., disclosing a system that integrates two or more categories of messages, such as e-mail and voice mail). *See* Specification 1, ll. 14-21. We acknowledge that Helfman discloses an e-mail system (col. 2, ll. 1-2) and a voice mail system (col. 7, ll. 29-33). Nevertheless, we find the weight of the evidence indicates that these systems are *separate embodiments* of Helfman's

invention. In particular, we note that Helfman discloses “*In one form of the invention*, a recipient of e-mail messages creates multiple mailboxes ...” (col. 1, ll. 41-42, emphasis added). Therefore, we find that Helfman does not fairly disclose a “unified messaging system” in accordance with the plain meaning of the term “unified” and further consistent with Appellants’ Specification. Accordingly, we reverse the Examiner’s rejection of claim 4 as being anticipated by Helfman.

Claims 5 and 6

Because claims 5 and 6 each depend upon claim 4, we will also reverse the Examiner’s rejection of these claims for the same reasons discussed *supra* with respect to claim 4.

Claims 3 and 9-11

We consider next the Examiner’s rejection of dependent claims 3 and 9-11 as being unpatentable over Helfman in view of Sylvan. Since Appellants’ arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select claim 3 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that Sylvan does not overcome the deficiencies of Helfman, as previously argued (Br. 16).

In response, we find no deficiencies in Helfman except regarding the “unified messaging system,” as discussed *supra* with respect to claim 4. Because such “unified messaging system” is not recited in claims 3 and 9-

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11, we will sustain the Examiner's rejection of these claims for the same reasons discussed *supra* with respect to claim 14 which recites essentially equivalent limitations to claim 1. We note that claims 3 and 9-11 depend directly or indirectly from claim 2 that, in turn, depends upon claim 1.

DECISION

We have sustained the Examiner's rejection of claims 1-3 and 7-20 but we have reversed the Examiner's rejection of claims 4-6. Therefore, the decision of the Examiner rejecting claims 1-20 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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